

Appl. No. 09/684,488
Amdt. dated July 12, 2004
Reply to Office action of May 17, 2004

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the final Office action dated May 17, 2004. In this final Office action, the Examiner: 1) rejected pending claims 21-27 and 29-30 under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential elements; 2) rejected claims 21-22, 27, and 30 as allegedly being anticipated by NN9301473, IBM Technical Disclosure Bulletin (IBM Bulletin); 3) rejected claims 23-24, 26, and 28-29 as being unpatentable over IBM Bulletin in view of Guha (U.S. Patent No. 6,092,072); and 4) concluded that claim 25 contained allowable subject matter.

With this Preliminary Amendment, Applicants amend the specification, amend claims 21, 22, 25, and 29, cancel claim 28, and present new claims 31-49. Applicants respectfully request reconsideration and allowance of the pending claims.

I. AMENDMENTS TO THE SPECIFICATION

The specification is amended to change the phrase "The present invention provides the following predetermined metric" to read "This embodiment of the present invention provides the following predetermined metric." This amendment is made to remove the possibility of erroneously interpreting the predetermined metric as a required feature, *i.e.*, essential element, of the claims. No new matter is introduced by this amendment.

This amendment is supported in the specification because the amended paragraph is part of the description of Fig. 3. See Applicants' Specification, page 13 line 20 – page 16 line 8. Fig. 3 is expressly described as illustrating an aggregated clustering method "according to one embodiment of the invention." Applicants' Specification, page 13 lines 20-21.

II. AMENDMENTS TO CLAIMS 22 AND 29

Claim 22 is amended to correct the antecedent basis of "subset." Claim 29 is amended to change the dependency of the claim in view of the cancellation of claim 28, to correctly refer to "the system as defined" rather than "the computer readable medium, and to correct typographical errors in the subscripts of the expression. No new matter is introduced by these claim amendments.

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III. SECTION 112, SECOND PARAGRAPH REJECTIONS

The Examiner rejected claims 21-27 and 29-30 as allegedly being incomplete for omitting essential elements, stating that the predetermined metric is the omitted element. Applicants believe that one of ordinary skill in the art would not read Applicants' specification to require the specific predetermined metric illustrated and have amended the specification to avoid such interpretations.

IV. THE CLAIM REJECTIONS

Claim 21 recites "receiving into the computer a size parameter for specifying the number of data points to be simultaneously evaluated for inclusion in a cluster."

The IBM Bulletin discloses that "Max_size" is the "size of the largest cluster." IBM Bulletin, page 4 line 24. Size is defined to be "a combined measure of the area, IO count, power consumption of a circuit." IBM Bulletin, page 5 lines 17-19. Therefore, Max_size appears to be the combined sizes of the circuits in a cluster, not the number of circuits in a cluster. The IBM Bulletin further distinguishes between size and number of circuits: "If the total number of circuits in the two clusters is below a control limit (clustering parameter), then merge the two clusters into one. One may use total size instead of the total number of circuits." IBM Bulletin, page 3 lines 13-19. The IBM Bulletin does not teach or suggest "a size parameter for specifying the number of data points to be simultaneously evaluated for inclusion in a cluster."

Base on the foregoing, Applicants respectfully submit that claim 21, and all claims which depend from claim 21 (claims 22-30) should be allowed. Claim 21 is amended to replace the erroneous reference to "step (d)" with a reference to the method step previously labeled (d).

V. ALLOWABLE SUBJECT MATTER

The Examiner objected to claim 25 as being dependent on a rejected base claim, but would be allowable if rewritten in Independent form including all of the limitations of the base claim and any intervening claims. Claim 25 is rewritten

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and is also amended to correct the omission of "point" after "data." Claim 25 is now allowable.

VI. NEW CLAIMS

With this Preliminary Amendment, Applicants submit new claims 31-49. Applicants respectfully submit that these new claims are allowable over the art of record.

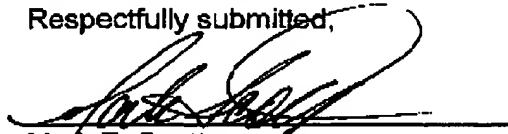
VII. CONCLUSION

Applicants respectfully request reconsideration and allowance of the pending claims. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-Packard Company Deposit Account Number 08-2025 and enter any time extension(s) necessary to prevent this case from being abandoned.

Respectfully submitted,



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